



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,245	02/23/2004	Richard D. Edwards	P114794	8864

22931 7590 01/03/2005

HUGHES LAW FIRM, PLLC
PACIFIC MERIDIAN PLAZA, SUITE 302
4164 MERIDIAN STREET
BELLINGHAM, WA 98226-5583

EXAMINER

WONG, STEVEN B

ART UNIT PAPER NUMBER

3711

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,245

Applicant(s)

EDWARDS ET AL.

Examiner

Steven Wong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-18-04</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 3711

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to a tool assembly, classified in class 473, subclass 408.
 - II. Claims 16-19, drawn to a method of repairing golf greens, classified in class 473, subclass 409.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as a method that does not require the apparatus to be placed in both the first and second operating positions to both repair a divot and perform a coring operation in a ground surface.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Robert Hughes on December 22, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitehead (823,571). Regarding claim 1, Whitehead discloses a tool assembly comprising a handle section (A) having a handle grip portion and a connecting portion (note Figure 1), an elongate operating section (B) comprising a first end portion having a green divot repair portion (b) and a second end portion having a coring tool portion (b). Note Figure 1 and lines 40-43 stating that either end (b) may be used. The end portions are inherently capable of repairing divots on a golf green or coring sections of the ground.

Regarding claim 4, note Figure 1 showing the handle portion and connecting portion in telescoping relationship.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehead (823,571). Regarding claim 5, Whitehead teaches a telescoping relationship between the handle

Art Unit: 3711

portion and the connecting portion, however, Whitehead teaches for the connecting portion to be inserted within the handle portion. It would have been obvious to one of ordinary skill in the art to have the handle portion be inserted within the connecting portion as such represents a mere reversal of parts and their associated functions and to do so would have been obvious in order to provide an alternative embodiment to the arrangement disclosed by Whitehead.

Regarding claim 6, note the rejections of claims 1 and 5 above.

Regarding claim 7, Whitehead includes a shaft locking portion (C). Note Figures 4 and 5. Also, Whitehead includes a locking portion (D) adapted to engage the shaft locking portion.

Regarding claim 8, Whitehead includes a protrusion/recess engagement between the shaft locking portion and the extension member locking portion.

Regarding claim 9, the bolts (C) provide a positioning function to resist rotational movement.

Regarding claim 10, the handle grip portion (A) includes first and second ends with the locking portion (C) being positioned towards the second end and the locking portions (D) of the extension member are located at the first and second end portions. Note Figure 1 showing a substantial portion of the members overlapping.

Regarding claim 11, the locking arrangement (C, D) of Whitehead provides a slot for insertion of the bolt to prevent rotational movement. The holes and bolt of Whitehead provide a protrusion/recess arrangement.

Regarding claim 12, note Figure 1 showing a substantial portion overlapping. Further, extension member (B) of Whitehead provides an interior chamber that is capable of moving cores successively up the chamber as additional cores are dug.

Regarding claim 13, the extension member (B) of Whitehead provides an opening distant from the coring end (b) that allows access to the chamber.

Regarding claims 14 and 15, note Figure 1 showing a substantial portion overlapping. Further, note the user's hand indicating that at least six inches overlap between the extension member and the handle portion. In the alternative, it would have been obvious to one of ordinary skill in the art to have the portions overlap at least six inches in order to maintain a strong connecting between the two members.

Allowable Subject Matter

9. Claims 2 and 3 appear to read over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

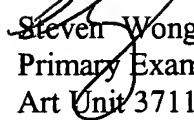
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/785,245

Page 6

Art Unit: 3711


Steven Wong
Primary Examiner
Art Unit 3711

SBW

December 27, 2004